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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,658	06/26/2003	Thimmappa Shivanandappa	39562-189637	4020
26694	7590	03/29/2004	EXAMINER	
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			REYES, HECTOR M	
			ART UNIT	PAPER NUMBER

1625

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/603,658

Applicant(s)

SHIVANANDAPPA ET AL.

Examiner

Hector M Reyes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/17/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of The Claims

Claims 2-4, 7-9 and 11 to 14 have been canceled via preliminary amendment. Currently claims 1, 5, 6 and 10 are under Examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the potential application of a giving compound as a drug is not considered an invention statutorily.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility or a well established utility. A potential treatment lacks utility because it is only an allegation or possibility.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1, 5, 6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1, 5, 6 and 10 are indefinite because it is unclear what is the invention being claimed. The said claims contain more than one invention: a compound and methods of using the same in the same body claim. Thus, they are considered hybrid claims.

For instance, in claim 1, it is not clear if the invention being claimed is the compound described as Formula (I) or on the other hand a method of using the said compound in the inhibition of acetylcholinesterase.

Moreover, in claim 1, it is unclear the meaning of the phrase "having primarily.." Is there a secondary enzyme to be inhibited by the said compound? In addition, the phrase "is obtained from fungus *Sporotrichum* species" is indefinite because it is not clear if it refers back to the source of the enzyme or to the compound. If the said phrase refers back to the compound, Is the activity of the compound dependable from the method for obtaining the compound? Would it be expected the same activity from the said compound even though it is prepared by an alternative method?

Alternatively claims 5, 6 and 10 are rejected because the said claims are duplicated claims of claim 1. Claim 5, 6 and 10 are directed to "a compound..." that already has been claimed in claim 1.

In claim 10, the phrase "having potential application as a drug for..." is indefinite. An invention cannot be defined as a possibility of an invention. The said phrase implies that it is unknown if there is indeed a method of treating Alzheimer's disease or dementia by using the said compound. How potential treatments would comply for example, with the utility or enablement requirements?

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Allowable Subject Matter

A compound having the formula (I) was not disclosed or suggest in the prior art. The only reference found disclosing the said compound was WO 2003082794, which is not considered prior art because it is not prior to the instant Application.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hector M. Reyes, whose telephone number is (571) 272-0691. The Examiner can normally be reached Monday through Friday from 8:30 to 4:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner 's supervisor Ms. Rita Desai can be reached at (571) 272-0684.

Hector M. Reyes, AU 1625
Reg # P-54,846
March 22, 2004

A handwritten signature in black ink, appearing to read "RDesai", with a horizontal line drawn underneath it.

**RITA DESAI
PRIMARY EXAMINER**